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APPEAL BRIEF

To: Commissioner for Patents
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Pursuant to 37 C.F.R. §41.37, Applicant hereby submits an appeal brief for application 09/843,102, filed April 24, 2001, within the requisite time from the date of filing the Notice of Appeal. Accordingly, Applicant appeals to the Board of Patent Appeals and Interferences seeking review of the Examiner's rejections.

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(1) Real Party in Interest

The real party in interest is Microsoft Corporation, the assignee of all right, title and interest in and to the subject invention.

(2) Related Appeals and Interferences

Appellant is not aware of any other appeals, interferences, or judicial proceedings which will directly affect, be directly affected by, or otherwise have a bearing on the Board's decision to this pending appeal.

(3) Status of Claims

Claims 1-17 and 20-52 stand rejected and are pending in this Application. Claims 1-17 and 20-52 are appealed. Some of claims 1-17 and 20-52 were previously amended. Claims 18, 19, and 53-57 were previously canceled. Claims 1-17 and 20-52 are set forth in the Appendix of Appealed Claims on page 44.

(4) Status of Amendments

A Final Office Action was issued on September 20, 2005.

A Response to the Final Office Action was filed November 21, 2005. No amendments were made as part of this Response.

An Advisory Action was issued on December 12, 2005, indicating that the request for reconsideration had been considered but did not place the application in condition for allowance.

Appellant filed a Notice of Appeal on January 20, 2006 in response to the Advisory Action and the Final Office Action.

(5) Summary of Claimed Subject Matter

A concise explanation of each of the independent claims is included in this Summary section, including specific reference characters. These specific reference characters are examples of particular elements of the drawings for certain embodiments of the claimed invention, and the claims are not limited to solely the elements corresponding to these reference characters.

With respect to independent claim 1, as discussed for example at page 5, line 19 through page 17, line 23, a system comprises a source database (134) and a content player (106). The source database (134) stores a plurality of highly compressed content pieces. The content player (106) includes an interface (168), a storage device (160), a comparator (172), a resolver (174), and an output controller (162). The interface (168) is to receive a subset of the plurality of highly compressed content pieces from the source database (134), and the storage device (160) is to store the subset. The comparator (172) is to compare the subset to content and determine whether the content matches any of the plurality of highly compressed content pieces in the subset. The resolver (174) is to take particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset. The output controller (162) is to render the content if the comparator (172) indicates the content does not match any of the highly compressed content pieces in the subset.

With respect to independent claim 9, as discussed for example at page 5, line 19 through page 17, line 23, a system comprises a source database (134) and a content player (106). The source database (134) stores a plurality of highly

compressed content pieces. The content player (106) includes an interface (168), a storage device (160), a comparator (172), and a resolver (174). The interface (168) is to receive a subset of the plurality of highly compressed content pieces from the source database (134), and the storage device (160) is to store the subset. The comparator (172) is to compare the subset to content and determine whether the content matches any of the plurality of highly compressed content pieces in the subset. The resolver (174) is to take particular action in response to the comparator (172) indicating the content matches one of the plurality of highly compressed content pieces in the subset. The storage device (160) is further to store a plurality of licenses identifying content that a user of the content player (106) is authorized to playback, and the particular action comprises the resolver (174) checking whether one of the plurality of licenses corresponds to the content.

With respect to independent claim 16, as discussed for example at page 5, line 19 through page 17, line 23, a system (106) comprises a memory (160), a comparator (172), and a resolver (174). The memory (160) stores one or more highly compressed content pieces. The comparator (172) is to compare the one or more highly compressed content pieces to content at the system (106) and to determine whether the content matches at least one of the one or more highly compressed content pieces. The resolver (174) is to take a particular action in response to the comparator (172) indicating the content matches one of the plurality of highly compressed content pieces in the subset, wherein the particular action comprises checking to see whether the system (106) has a valid license for the content.

With respect to independent claim 29, as discussed for example at page 5, line 19 through page 17, line 23, a portion of media content (130) is compared (206) to a set of one or more highly compressed pieces of content (132), and it is determined (206) whether the portion of media content (130) matches any of the set of highly compressed pieces (132). A programmed action is taken if the portion of media content (130) matches any of the set of highly compressed pieces (132). The content is played back (208) if the determining indicates the portion of media content (130) does not match any of the set of highly compressed pieces (132).

With respect to independent claim 37, as discussed for example at page 5, line 19 through page 17, line 23, a portion of media content (130) is compared (206) to a set of one or more highly compressed pieces of content (132), and it is determined (206) whether the portion of media content (130) matches any of the set of highly compressed pieces (132). A programmed action is taken if the portion of media content (130) matches any of the set of highly compressed pieces (132), wherein the programmed action comprises checking (210) whether one of a plurality of licenses maintained at a content player (106) performing the comparing (206) corresponds to the portion of media content (130).

With respect to independent claim 40, as discussed for example at page 5, line 19 through page 17, line 23, a portion of media content (130) is compared (206) to a set of one or more highly compressed pieces of content (132), and it is determined (206) whether the portion of media content (130) matches any of the set of highly compressed pieces (132). A programmed action is taken if the portion of media content (130) matches any of the set of highly compressed pieces

(132). The content is rendered (208) if the determining indicates the portion of media content (130) does not match any of the set of highly compressed pieces (132).

With respect to independent claim 41, as discussed for example at page 5, line 19 through page 17, line 23, a system comprises means for storing (specification: page 13, line 17 – page 14, line 3, and page 17, line 24 – page 22, line 11; drawings: 160, 346, 356, 360, 364) a set of highly compressed content pieces (132) and means for determining (specification: page 14, line 20 – page 21, line 7, page 17, lines 6 – 23, and page 17, line 24 – page 22, line 11; drawings: 172, 370, 372, 374) whether a portion of media content (130) matches any of the set of highly compressed content pieces (132). The system further comprises means for taking a particular action (specification: page 15, line 5 – page 17, line 23, and page 17, line 24 – page 22, line 11; drawings: 174, 370, 372, 374) if the portion of media content (130) matches any of the set of highly compressed content pieces (132), and means for playing back the content (specification: page 13, line 17 – page 14, line 3, and page 17, line 24 – page 22, line 11; drawings: 162, 370, 372, 374) if the determining indicates the portion of media content (130) does not match any of the set of highly compressed pieces (132).

With respect to independent claim 46, as discussed for example at page 5, line 19 through page 17, line 23, a check (206) is made as to whether a portion of media content (130) matches a piece of highly compressed content (132), wherein the piece of highly compressed content (132) cannot be played back to a user in an intelligible form. The portion of media content (130) is allowed to be played back (208) if the portion of media content (130) does not match the piece of highly

compressed content (132). A particular action is taken if the portion of media content (130) does match the piece of highly compressed content (132).

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 1-8, 11-15, 29-36, and 38-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,496,802 to van Zoest et al. and further in view of U.S. Patent Application Publication 2001/0051996 to Cooper et al.

Claims 9-10, 16-17, 20-28, and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,496,802 to van Zoest et al. and further in view of U.S. Patent No. 6,766,305 to Fucarile et al.

(7) Argument

A. Rejection under 35 U.S.C. §103(a) over U.S. Patent No. 6,496,802 to van Zoest et al. and further in view of U.S. Patent Application Publication 2001/0051996 to Cooper et al.

Claims 1-8, 11-15, 29-36, and 38-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,496,802 to van Zoest et al. (hereinafter "van Zoest") and further in view of U.S. Patent Application Publication 2001/0051996 to Cooper et al. (hereinafter "Cooper").

van Zoest is directed to a system and method for providing access to electronic works (see, Title). Such electronic works may include songs, albums, movies, music videos, or a variety of other types of work (see, col. 2, lines 25-27). When a user requests access to a work, van Zoest verifies that the user is entitled

to receive the desired work (see, col. 2, lines 36-40). This verification can be performed by the user demonstrating that they own a physical copy of the work or demonstrating that they ordered the requested work from a retailer or other distributor (see, col. 2, lines 40-44). Once the user adequately shows that they are authorized to receive the requested work, the user is provided with access to the work (see, col. 2, lines 45-47).

Cooper is directed to a network-based content distribution system (see, Title). In Cooper, a Copyright Registry System allows artists, copyright owners, and other content owners to register their valuable digital content (see, ¶ 94). A consumer requests that a content file be registered (see, ¶ 98), and a Copyright Registration System website issues a new and unique digital certificate or unique message for the content file (see, ¶ 100). The Copyright Registry System website also watermarks each content file with a serial number or message for each new and unique digital certificate issued (see, ¶ 101). The watermarked copy of the user's content can be distributed over a network, and the digital certificate or message is generated to prove the authenticity of the person who filed with the Copyright Registry (see, ¶¶ 119-120). A player of content can check the Content Registry system to see if an identical digital certificate is being played by another player device (see, ¶ 124). If there is no match (no identical digital certificate in the Content Registry system), then the content file plays normally (see, ¶ 124).

1. Claims 1-8 and 11-15

With respect to claim 1, claim 1 recites

A system comprising:
a source database storing a plurality of highly compressed content pieces; and
a content player, coupled to the source database, including,
an interface to receive a subset of the plurality of highly compressed content pieces from the source database,
a storage device to store the subset,
a comparator to compare the subset to content and determine whether the content matches any of the plurality of highly compressed content pieces in the subset,
a resolver to take particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset, and
an output controller to render the content if the comparator indicates the content does not match any of the highly compressed content pieces in the subset.

Appellant respectfully submits that no such system is disclosed by van Zoest and Cooper.

In the September 20, 2005 Final Office Action at p. 4, it was asserted that van Zoest at col. 5, paragraph 3, lines 1-6 and 12-15 discloses the resolver of claim 1. The cited portion of van Zoest reads:

Verification Server 141 verifies that the user is authorized to access an electronic work. The Verification Server 141 may perform a variety of tests or comparison to determine whether a user is authorized to access a work, such as, test a confirmation number, verify that the user possesses a physical work, or verify that the user purchased the work. . . . Based on this comparison, the Verification Server 141 may determine whether the user claiming possession of the physical work does, in fact, have possession and therefore is authorized to access an electronic work.

Thus, this cited portion of van Zoest discusses determination of whether the user is authorized to access a work, with one such test for making the determination being

verifying that the user possesses the physical work. As discussed in col. 5, paragraph 3, lines 19-25, accessing an electronic work includes obtaining access to listen to an electronic work or any other means of allowing a user to listen or watch the work. Thus, van Zoest discusses that, in response to the determination that the user is authorized to access a work (using the language of claim 1, this determination would be an indication that the content matches one of the plurality of highly compressed content pieces in the subset), the user is allowed to listen or watch the work.

Also in the September 20, 2005 Final Office Action at p. 4, it is acknowledged that van Zoest does not disclose the output controller of claim 1, but Cooper at paragraph 124 is relied on as disclosing the output controller of claim 1. This cited portion of Cooper reads:

With a Content Registry system 234, a player of content may check the registry to see if an identical digital certificate is being played by another player device. This may be achieved by communicating with the Copyright Registry 234 on-line using a network 116, for example the Internet, an Intranet, or other network. Certain in-use switches may be set to indicate that a user is currently using a particular content file. Following is an example of this. A software program that has been previously registered with the Copyright Registry 234 is initiated by an end user. During the program initialization process, the Copyright Registry 234 is checked to see if someone else is using the same software program with the same digital certificate. If so, then piracy has been detected and the author or publisher may decide how best to communicate an appropriate message to the parties using the software. If a no match condition is found, the content file plays normally. When the content file reaches its end, then the Copyright Registry 234 may be updated to indicate that the content file and the digital certificate for that content file are no longer being played. An in-use switch will be set back to False, Null, Zero, or other value that indicates the content is no longer being played.

Thus, it can be seen that Cooper discusses checking to see if someone else is using the same software program with the same digital certificate, and if a no match condition is found, the content file plays normally. Thus, assuming for the sake of argument that Cooper discloses the output controller as recited in claim 1 (as asserted in the September 20, 2005 Final Office Action), then Cooper would disclose to render the content if the comparator indicates the content does not match any of the highly compressed content pieces in the subset. And, as discussed above, van Zoest discusses that, in response to the determination that the user is authorized to access a work (using the language of claim 1, this determination would be an indication that the content matches one of the plurality of highly compressed content pieces in the subset), the user is allowed to listen or watch the work. Thus, if Cooper and van Zoest were to be combined, the result would be allowing rendering of the content if the content matches one of the plurality of highly compressed content pieces in the subset (per van Zoest), and allowing rendering of the content if the content does not match any of the highly compressed content pieces in the subset (per Cooper). It can thus be seen that the combination of van Zoest and Cooper would result in always allowing the content to be rendered, regardless of whether the content matches one of the plurality of highly compressed content pieces.

Such a result, however, contradicts both van Zoest and Cooper. If the rendering of the content of Cooper were allowed if the content matches one of the plurality of highly compressed content pieces in the subset, then it would negate any benefits of Cooper in allowing rendering of the content only if the content does not match any of the highly compressed content pieces in the subset.

Similarly, if the rendering of the content of van Zoest were allowed if the content does not match any of the highly compressed content pieces in the subset, then it would negate any benefits of van Zoest in allowing rendering of the content only if the content matches one of the plurality of highly compressed content pieces in the subset.

Per MPEP §2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed above, combining van Zoest and Cooper would change the principle of operation of both van Zoest and Cooper because the combination would negate the benefits asserted by each. As such, Appellant respectfully submits that claim 1 cannot be disclosed or suggested by van Zoest and Cooper.

Furthermore, per MPEP §2145 X.D.2, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The references teach away from their combination because, as discussed above, the combination of van Zoest and Cooper would negate the benefits asserted by each. As such, Appellant respectfully submits that claim 1 cannot be disclosed or suggested by van Zoest and Cooper.

In addition, assuming for the sake of argument that van Zoest and Cooper were combined, in the December 12, 2005 Advisory Action it was asserted with respect to the combination of van Zoest and Cooper that:

The combination would not create an either or situation as the applicant has stated, but instead would create a situation where both

“tests” would need to pass in order to access the content. In this case, the system would compare the content to a database of known content to determine whether the user was in possession of the physical work (See van Zoest Col. 5 Paragraph 3). Then the system, as taught by Cooper, would compare the content with database of content currently being used by other users to determine whether the content was a duplicate. If the content was a duplicate, it would not be rendered, thereby protecting against the use of duplicate copies of the content as taught by Cooper (See Cooper Paragraph 0124). As such, the two comparisons are used together and produce a more secure result, and the system would play the content only if it was recognized content, and not content currently being played by another user.

Appellant respectfully disagrees with this characterization of van Zoest and Cooper.

In claim 1, the resolver and the output controller both operate based on the same plurality of highly compressed content pieces in the subset. Thus, in order to disclose all of the elements of claim 1, the same highly compressed content pieces in the subset would need to be used for the comparison in van Zoest as well as for the comparison in Cooper. However, Cooper does not disclose a highly compressed content piece. Rather, as discussed above Cooper discloses that a Copyright Registration System website issues a new and unique digital certificate or unique message for the content file, and checking the Content Registry System to see if an identical digital certificate is being played by another player device. The digital certificate in Cooper allows each content file to be uniquely identified. Cooper could not use a highly compressed content piece because Cooper requires a unique identifier for each content file in order to ensure that the content file is not played by two different players concurrently, and the highly compressed content piece would not provide that uniqueness. As such, Appellant respectfully submits that Cooper cannot disclose an output controller to render the content if

the comparator indicates the content does not match any of the highly compressed content pieces in the subset as recited in claim 1.

Accordingly, for at least these reasons, Appellant respectfully submits that claim 1 is allowable over van Zoest in view of Cooper.

With respect to claims 2-8 and 11-15, given that claims 2-8 and 11-15 depend from claim 1, Appellant respectfully submits that claims 2-8 and 11-15 are likewise allowable over van Zoest in view of Cooper for at least the reasons discussed above with respect to claim 1.

2. Claims 29-36 and 38-39

With respect to claim 29, claim 29 recites:

A method comprising:
comparing a portion of media content to a set of one or more highly compressed pieces of content;
determining whether the portion of media content matches any of the set of highly compressed pieces;
taking a programmed action if the portion of media content matches any of the set of highly compressed pieces; and
playing back the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces.

Appellant respectfully submits that no such method is disclosed by van Zoest and Cooper.

In the September 20, 2005 Final Office Action it was asserted that Cooper discloses playing back the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces as recited in claim 29. Furthermore, as discussed above with respect to claim 1, van Zoest discusses that, in response to the determination that the user is authorized to access

a work (using the language of claim 29, this determination would be taking a programmed action if the portion of media content matches any of the set of highly compressed pieces), the user is allowed to listen or watch the work. Thus, if Cooper and van Zoest were to be combined, the result would be allowing rendering of the content if the content matches one of the plurality of highly compressed content pieces in the set (per van Zoest), and allowing rendering of the content if the content does not match any of the highly compressed content pieces in the set (per Cooper). It can thus be seen that the combination of van Zoest and Cooper would result in always allowing the content to be rendered, regardless of whether the content matches one of the plurality of highly compressed content pieces.

Such a result, however, contradicts both van Zoest and Cooper. If the rendering of the content of Cooper were allowed if the content matches one of the plurality of highly compressed content pieces in the set, then it would negate any benefits of Cooper in allowing rendering of the content only if the content does not match any of the highly compressed content pieces in the set. Similarly, if the rendering of the content of van Zoest were allowed if the content does not match any of the highly compressed content pieces in the set, then it would negate any benefits of van Zoest in allowing rendering of the content only if the content matches one of the plurality of highly compressed content pieces in the set.

Per MPEP §2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA

1959). As discussed above, combining van Zoest and Cooper would change the principle of operation of both van Zoest and Cooper because the combination would negate the benefits asserted by each. As such, Appellant respectfully submits that claim 29 cannot be disclosed or suggested by van Zoest and Cooper.

Furthermore, per MPEP §2145 X.D.2, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The references teach away from their combination because, as discussed above, the combination of van Zoest and Cooper would negate the benefits asserted by each. As such, Appellant respectfully submits that claim 29 cannot be disclosed or suggested by van Zoest and Cooper.

In addition, assuming for the sake of argument that van Zoest and Cooper were combined, in the December 12, 2005 Advisory Action it was asserted with respect to the combination of van Zoest and Cooper that:

The combination would not create an either or situation as the applicant has stated, but instead would create a situation where both “tests” would need to pass in order to access the content. In this case, the system would compare the content to a database of known content to determine whether the user was in possession of the physical work (See van Zoest Col. 5 Paragraph 3). Then the system, as taught by Cooper, would compare the content with database of content currently being used by other users to determine whether the content was a duplicate. If the content was a duplicate, it would not be rendered, thereby protecting against the use of duplicate copies of the content as taught by Cooper (See Cooper Paragraph 0124). As such, the two comparisons are used together and produce a more secure result, and the system would play the content only if it was recognized content, and not content currently being played by another user.

Appellant respectfully disagrees with this characterization of van Zoest and Cooper.

In claim 29, the taking a programmed action and the playing back the content are both based on the same set of highly compressed pieces of content. Thus, in order to disclose all of the elements of claim 29, the same set of highly compressed pieces of content would need to be used for the comparison in van Zoest as well as for the comparison in Cooper. However, Cooper does not disclose a highly compressed piece of content. Rather, as discussed above Cooper discloses that a Copyright Registration System website issues a new and unique digital certificate or unique message for the content file, and checking the Content Registry System to see if an identical digital certificate is being played by another player device. The digital certificate in Cooper allows each content file to be uniquely identified. Cooper could not use a highly compressed piece of content because Cooper requires a unique identifier for each content file in order to ensure that the content file is not played by two different players concurrently, and the highly compressed piece of content would not provide that uniqueness. As such, Appellant respectfully submits that Cooper cannot disclose playing back the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces of content as recited in claim 29.

Accordingly, for at least these reasons, Appellant respectfully submits that claim 29 is allowable over van Zoest in view of Cooper.

With respect to claims 30-36 and 38-39, given that claims 30-36 and 38-39 depend from claim 29, Appellant respectfully submits that claims 30-36 and 38-39

are likewise allowable over van Zoest in view of Cooper for at least the reasons discussed above with respect to claim 29.

3. Claim 40

With respect to claim 40, claim 40 recites:

One or more computer-readable memories containing a computer program that is executable by a processor to perform a method comprising:

comparing a portion of media content to a set of one or more highly compressed pieces of content;

determining whether the portion of media content matches any of the set of highly compressed pieces;

taking a programmed action if the portion of media content matches any of the set of highly compressed pieces; and

rendering the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces.

Appellant respectfully submits that no such method is disclosed by van Zoest and Cooper.

In the September 20, 2005 Final Office Action it was asserted that Cooper discloses rendering the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces as recited in claim 40. Furthermore, as discussed above with respect to claim 1, van Zoest discusses that, in response to the determination that the user is authorized to access a work (using the language of claim 40, this determination would be taking a programmed action if the portion of media content matches any of the set of highly compressed pieces), the user is allowed to listen or watch the work. Thus, if Cooper and van Zoest were to be combined, the result would be allowing rendering of the content if the content matches one of the plurality of highly

compressed content pieces in the set (per van Zoest), and allowing rendering of the content if the content does not match any of the highly compressed content pieces in the set (per Cooper). It can thus be seen that the combination of van Zoest and Cooper would result in always allowing the content to be rendered, regardless of whether the content matches one of the plurality of highly compressed content pieces in the set.

Such a result, however, contradicts both van Zoest and Cooper. If the rendering of the content of Cooper were allowed if the content matches one of the plurality of highly compressed content pieces in the set, then it would negate any benefits of Cooper in allowing rendering of the content only if the content does not match any of the highly compressed content pieces in the set. Similarly, if the rendering of the content of van Zoest were allowed if the content does not match any of the highly compressed content pieces in the set, then it would negate any benefits of van Zoest in allowing rendering of the content only if the content matches one of the plurality of highly compressed content pieces in the set.

Per MPEP §2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed above, combining van Zoest and Cooper would change the principle of operation of both van Zoest and Cooper because the combination would negate the benefits asserted by each. As such, Appellant respectfully submits that claim 40 cannot be disclosed or suggested by van Zoest and Cooper.

Furthermore, per MPEP §2145 X.D.2, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The references teach away from their combination because, as discussed above, the combination of van Zoest and Cooper would negate the benefits asserted by each. As such, Appellant respectfully submits that claim 40 cannot be disclosed or suggested by van Zoest and Cooper.

In addition, assuming for the sake of argument that van Zoest and Cooper were combined, in the December 12, 2005 Advisory Action it was asserted with respect to the combination of van Zoest and Cooper that:

The combination would not create an either or situation as the applicant has stated, but instead would create a situation where both “tests” would need to pass in order to access the content. In this case, the system would compare the content to a database of known content to determine whether the user was in possession of the physical work (See van Zoest Col. 5 Paragraph 3). Then the system, as taught by Cooper, would compare the content with database of content currently being used by other users to determine whether the content was a duplicate. If the content was a duplicate, it would not be rendered, thereby protecting against the use of duplicate copies of the content as taught by Cooper (See Cooper Paragraph 0124). As such, the two comparisons are used together and produce a more secure result, and the system would play the content only if it was recognized content, and not content currently being played by another user.

Appellant respectfully disagrees with this characterization of van Zoest and Cooper.

In claim 40, the taking a programmed action and the rendering the content are both based on the same set of highly compressed pieces of content. Thus, in order to disclose all of the elements of claim 40, the same highly compressed

pieces of content in the set would need to be used for the comparison in van Zoest as well as for the comparison in Cooper. However, Cooper does not disclose a highly compressed piece of content. Rather, as discussed above Cooper discloses that a Copyright Registration System website issues a new and unique digital certificate or unique message for the content file, and checking the Content Registry System to see if an identical digital certificate is being played by another player device. The digital certificate in Cooper allows each content file to be uniquely identified. Cooper could not use a highly compressed piece of content because Cooper requires a unique identifier for each content file in order to ensure that the content file is not played by two different players concurrently, and the highly compressed piece of content would not provide that uniqueness. As such, Appellant respectfully submits that Cooper cannot disclose rendering the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces of content as recited in claim 40.

Accordingly, for at least these reasons, Appellant respectfully submits that claim 40 is allowable over van Zoest in view of Cooper.

4. Claims 41-45

With respect to claim 41, claim 41 recites:

A system comprising:
means for storing a set of highly compressed content pieces;
means for determining whether a portion of media content
matches any of the set of highly compressed content pieces;
means for taking a particular action if the portion of media
content matches any of the set of highly compressed content pieces;
and

means for playing back the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces.

Appellant respectfully submits that no such system is disclosed by van Zoest and Cooper.

In the September 20, 2005 Final Office Action it was asserted that Cooper discloses the means for playing back the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces as recited in claim 41. Furthermore, as discussed above with respect to claim 1, van Zoest discusses that, in response to the determination that the user is authorized to access a work (using the language of claim 41, this determination would be a result of the means for taking a particular action if the portion of media content matches any of the set of highly compressed content pieces), the user is allowed to listen or watch the work. Thus, if Cooper and van Zoest were to be combined, the result would be allowing rendering of the content if the content matches one of the plurality of highly compressed content pieces in the set (per van Zoest), and allowing rendering of the content if the content does not match any of the highly compressed content pieces in the set (per Cooper). It can thus be seen that the combination of van Zoest and Cooper would result in always allowing the content to be rendered, regardless of whether the content matches one of the plurality of highly compressed content pieces.

Such a result, however, contradicts both van Zoest and Cooper. If the rendering of the content of Cooper were allowed if the content matches one of the plurality of highly compressed content pieces in the set, then it would negate any benefits of Cooper in allowing rendering of the content only if the content does not match any of the highly compressed content pieces in the set. Similarly, if the

rendering of the content of van Zoest were allowed if the content does not match any of the highly compressed content pieces in the set, then it would negate any benefits of van Zoest in allowing rendering of the content only if the content matches one of the plurality of highly compressed content pieces in the set.

Per MPEP §2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed above, combining van Zoest and Cooper would change the principle of operation of both van Zoest and Cooper because the combination would negate the benefits asserted by each. As such, Appellant respectfully submits that claim 41 cannot be disclosed or suggested by van Zoest and Cooper.

Furthermore, per MPEP §2145 X.D.2, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The references teach away from their combination because, as discussed above, the combination of van Zoest and Cooper would negate the benefits asserted by each. As such, Appellant respectfully submits that claim 41 cannot be disclosed or suggested by van Zoest and Cooper.

In addition, assuming for the sake of argument that van Zoest and Cooper were combined, in the December 12, 2005 Advisory Action it was asserted with respect to the combination of van Zoest and Cooper that:

The combination would not create an either or situation as the applicant has stated, but instead would create a situation where both “tests” would need to pass in order to access the content. In this case, the system would compare the content to a database of known

content to determine whether the user was in possession of the physical work (See van Zoest Col. 5 Paragraph 3). Then the system, as taught by Cooper, would compare the content with database of content currently being used by other users to determine whether the content was a duplicate. If the content was a duplicate, it would not be rendered, thereby protecting against the use of duplicate copies of the content as taught by Cooper (See Cooper Paragraph 0124). As such, the two comparisons are used together and produce a more secure result, and the system would play the content only if it was recognized content, and not content currently being played by another user.

Appellant respectfully disagrees with this characterization of van Zoest and Cooper.

In claim 41, the means for taking a particular action and the means for playing back the content are both based on the same set of highly compressed content pieces. Thus, in order to disclose all of the elements of claim 41 the same highly compressed content pieces in the set would need to be used for the comparison in van Zoest as well as for the comparison in Cooper. However, Cooper does not disclose a highly compressed content piece. Rather, as discussed above Cooper discloses that a Copyright Registration System website issues a new and unique digital certificate or unique message for the content file, and checking the Content Registry System to see if an identical digital certificate is being played by another player device. The digital certificate in Cooper allows each content file to be uniquely identified. Cooper could not use a highly compressed content piece because Cooper requires a unique identifier for each content file in order to ensure that the content file is not played by two different players concurrently, and the highly compressed content piece would not provide that uniqueness. As such, Appellant respectfully submits that Cooper cannot disclose means for playing back

the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces as recited in claim 41.

Accordingly, for at least these reasons, Appellant respectfully submits that claim 41 is allowable over van Zoest in view of Cooper.

With respect to claims 42-45, given that claims 42-45 depend from claim 41, Appellant respectfully submits that claims 42-45 are likewise allowable over van Zoest in view of Cooper for at least the reasons discussed above with respect to claim 41.

5. Claims 46-52

With respect to claim 46, claim 46 recites:

One or more computer-readable media having stored thereon a plurality of instructions that, when executed by one or more processors of a computer, causes the one or more processors to perform acts including:

checking whether a portion of media content matches a piece of highly compressed content, wherein the piece of highly compressed content cannot be played back to a user in an intelligible form;

allowing the portion of media content to be played back if the portion of media content does not match the piece of highly compressed content; and

taking a particular action if the portion of media content does match the piece of highly compressed content.

Appellant respectfully submits that no such checking, allowing, and taking is disclosed by van Zoest and Cooper.

In the September 20, 2005 Final Office Action it was asserted that Cooper discloses the allowing the portion of media content to be played back if the portion of media content does not match the piece of highly compressed content as recited

in claim 46. Furthermore, as discussed above with respect to claim 1, van Zoest discusses that, in response to the determination that the user is authorized to access a work (using the language of claim 46, this determination would be the taking a particular action if the portion of media content does match the piece of highly compressed content), the user is allowed to listen or watch the work. Thus, if Cooper and van Zoest were to be combined, the result would be allowing rendering of the content if the content matches a piece of highly compressed content (per van Zoest), and allowing rendering of the content if the content does not match the piece of highly compressed content (per Cooper). It can thus be seen that the combination of van Zoest and Cooper would result in always allowing the content to be rendered, regardless of whether the content matches the piece of highly compressed content.

Such a result, however, contradicts both van Zoest and Cooper. If the rendering of the content of Cooper were allowed if the content matches the piece of highly compressed content, then it would negate any benefits of Cooper in allowing rendering of the content only if the content does not match the piece of highly compressed content. Similarly, if the rendering of the content of van Zoest were allowed if the content does not match the piece of highly compressed content, then it would negate any benefits of van Zoest in allowing rendering of the content only if the content matches the piece of highly compressed content.

Per MPEP §2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA

1959). As discussed above, combining van Zoest and Cooper would change the principle of operation of both van Zoest and Cooper because the combination would negate the benefits asserted by each. As such, Appellant respectfully submits that claim 46 cannot be disclosed or suggested by van Zoest and Cooper.

Furthermore, per MPEP §2145 X.D.2, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The references teach away from their combination because, as discussed above, the combination of van Zoest and Cooper would negate the benefits asserted by each. As such, Appellant respectfully submits that claim 46 cannot be disclosed or suggested by van Zoest and Cooper.

In addition, assuming for the sake of argument that van Zoest and Cooper were combined, in the December 12, 2005 Advisory Action it was asserted with respect to the combination of van Zoest and Cooper that:

The combination would not create an either or situation as the applicant has stated, but instead would create a situation where both “tests” would need to pass in order to access the content. In this case, the system would compare the content to a database of known content to determine whether the user was in possession of the physical work (See van Zoest Col. 5 Paragraph 3). Then the system, as taught by Cooper, would compare the content with database of content currently being used by other users to determine whether the content was a duplicate. If the content was a duplicate, it would not be rendered, thereby protecting against the use of duplicate copies of the content as taught by Cooper (See Cooper Paragraph 0124). As such, the two comparisons are used together and produce a more secure result, and the system would play the content only if it was recognized content, and not content currently being played by another user.

Appellant respectfully disagrees with this characterization of van Zoest and Cooper.

In claim 46, the allowing the portion of media content to be played back and the taking a particular action are both based on the same piece of highly compressed content. Thus, in order to disclose all of the elements of claim 46 the same highly compressed content piece would need to be used for the comparison in van Zoest as well as for the comparison in Cooper. However, Cooper does not disclose a highly compressed content piece. Rather, as discussed above Cooper discloses that a Copyright Registration System website issues a new and unique digital certificate or unique message for the content file, and checking the Content Registry System to see if an identical digital certificate is being played by another player device. The digital certificate in Cooper allows each content file to be uniquely identified. Cooper could not use a highly compressed content piece because Cooper requires a unique identifier for each content file in order to ensure that the content file is not played by two different players concurrently, and the highly compressed content piece would not provide that uniqueness. As such, Appellant respectfully submits that Cooper cannot disclose allowing the portion of media content to be played back if the portion of media content does not match the piece of highly compressed content as recited in claim 46.

Accordingly, for at least these reasons, Appellant respectfully submits that claim 46 is allowable over van Zoest in view of Cooper.

With respect to claims 47-52, given that claims 47-52 depend from claim 46, Appellant respectfully submits that claims 47-52 are likewise allowable over

van Zoest in view of Cooper for at least the reasons discussed above with respect to claim 46.

B. Rejection under 35 U.S.C. §103(a) over U.S. Patent No. 6,496,802 to van Zoest et al. and further in view of U.S. Patent No. 6,766,305 to Fucarile et al.

Claims 9-10, 16-17, 20-28, and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,496,802 to van Zoest et al. (hereinafter "van Zoest") and further in view of U.S. Patent No. 6,766,305 to Fucarile et al. (hereinafter "Fucarile").

Fucarile is directed to systems and methods for embedded licensing in a distributed computer environment (see, col. 1, lines 8-9). Fucarile includes a plug-in or application running on a user computer (see, col. 3, lines 34-35). The plug-in is adapted to access content on a content server (see, col. 3, lines 35-36). The content includes a special licensing form and the plug-in is further adapted to scan the content for such licensing form (see, col. 3, lines 36-38). Depending on the information in the licensing form, the plug-in determines if the license governing the content is an implicit or explicit license (see, col. 3, lines 39-41). If the license is valid, the content is processed (see, col. 3, lines 44-45).

1. Claims 9 and 10

Appellant respectfully submits that it would not have been obvious to one of ordinary skill in the art to combine van Zoest and Fucarile. As discussed above, when a user requests access to an electronic work, van Zoest verifies that the user

is entitled to receive the desired electronic work (see, col. 2, lines 36-40). Once the user adequately shows that they are authorized to receive the requested electronic work, the user is provided with access to the electronic work (see, col. 2, lines 45-47). A variety of tests or comparisons may be performed to determine whether a user is authorized to access an electronic work, such as test a confirmation number, verify that the user possesses a physical work, or verify that the user purchased the work (see, col. 5, lines 22-26).

In the September 20, 2005 Final Office Action at p. 3, it was asserted that Fucarile at col. 3, lines 8-45 “teaches that mere possession of content is not enough to authorize access to the content and provides a means utilizing the checking and validation of licenses in the content”. However, the content that is discussed in Fucarile is content that is received from a server over a network (see, for example, col. 6, lines 23-25, col. 8, lines 62-67, and col. 9, lines 30-35). **This content of Fucarile is thus analogous to the electronic work of van Zoest.** van Zoest does not discuss that mere possession of the electronic work is enough to authorize access to the electronic work; rather, verification that the user possesses the physical work (e.g., the physical CD (see, van Zoest at col. 1, lines 61-64)) or some other verification is needed in van Zoest in order to access the electronic work. The license mechanism of Fucarile, then, is at best another mechanism by which the verification of van Zoest could be performed, and is not another verification performed in addition to the verification performed by van Zoest.

Appellant respectfully submits that there is no suggestion or motivation to combine van Zoest and Fucarile, and thus that no *prima facie* case of obviousness has been established. One of ordinary skill in the art would not have been

motivated to use the techniques of Fucarile to perform a verification that had already been performed by van Zoest. As there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to use the techniques of Fucarile to perform a verification that had already been performed by van Zoest, Appellant respectfully submits that it would not have been obvious to combine van Zoest and Fucarile.

As discussed in MPEP §2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Accordingly, Appellant respectfully submits that the mere fact that van Zoest and Fucarile can be combined does not render the resultant combination obvious because the prior art does not suggest the desirability of the combination.

Furthermore, assuming for the sake of argument that van Zoest and Fucarile were combined, Appellant respectfully submits that the combination of van Zoest and Fucarile does not disclose or suggest the system of claim 9. Claim 9 recites:

A system comprising:
a source database storing a plurality of highly compressed content pieces; and
a content player, coupled to the source database, including,
an interface to receive a subset of the plurality of highly compressed content pieces from the source database,
a storage device to store the subset,
a comparator to compare the subset to content and determine whether the content matches any of the plurality of highly compressed content pieces in the subset, and
a resolver to take particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset,
wherein the storage device is further to store a plurality of licenses identifying content that a user of the content player is authorized to playback, and wherein the particular

action comprises the resolver checking whether one of the plurality of licenses corresponds to the content.

Appellant respectfully submits that no such system is disclosed or suggested by van Zoest in view of Fucarile.

As can be seen in claim 9, the content player includes a comparator to compare the subset to content and determine whether the content matches any of the plurality of highly compressed content pieces in the subset, and a resolver to take particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset. This particular action in claim 9 comprises the resolver checking whether one of the plurality of licenses corresponds to the content.

In the September 20, 2005 Final Office Action at p. 8, it is acknowledged that van Zoest does not disclose wherein the storage device is further to store a plurality of licenses identifying content that a user of the content player is authorized to playback, and wherein the particular action comprises the resolver checking whether one of the plurality of licenses corresponds to the content, but it is asserted that this element is disclosed by Fucarile.

However, as discussed above, in van Zoest once the user adequately shows that they are authorized to receive the requested work, the user is provided with access to the work (see, col. 2, lines 45-47). This verification can be performed by the user demonstrating that they own a physical copy of the work or demonstrating that they ordered the requested work from a retailer or other distributor (see, col. 2, lines 40-44). Possession of the physical work in van Zoest (not mere possession of the electronic work) or some other verification is needed in van Zoest. After the user in van Zoest has adequately shown that they are authorized to receive the

requested electronic work by passing some verification that extends beyond merely having a copy of the electronic work, it would have been nonsensical for a check to then be made as to whether one of a plurality of licenses corresponds to the content. Such a check would simply verify what has already been verified by some other means.

In the September 20, 2005 Final Office Action at p. 3, it was asserted that “it would not have been nonsensical to check for a valid license once it was determined in van Zoest that the user possessed the content”. Appellant respectfully disagrees and submits that it would have been nonsensical to check for a valid license once it was determined in van Zoest that the user was authorized to access the electronic work. The possession of the physical work in van Zoest authorizes the user to access the electronic work – there is no discussion or mention in either van Zoest or Fucarile of needing any additional authorization beyond such possession of the physical work. Authorization to access the electronic work in van Zoest is verified by the presence of the physical work. **Embedding a license of Fucarile in the electronic work in van Zoest would not be needed in combination with verifying the presence of the physical work in van Zoest because both would serve the same function – to verify authorization to access the electronic work.** As such, Appellant respectfully submits that it would have been nonsensical to check for a valid license in van Zoest to determine whether a user is authorized to access the electronic work after it was already determined that the user was authorized to access the electronic work.

In addition, in the December 12, 2005 Advisory Action it was asserted with respect to the combination of van Zoest and Fucarile that:

Regarding applicant's argument that the license system of Fucarile would not be performed in addition to the comparison of van Zoest and therefore would be nonsensical to make the combination, the examiner does not find the argument persuasive. Once again, the applicant has mischaracterized the rejection. In this case, the system would compare the content to a database of known content to determine whether the user was in possession of the physical work (See van Zoest Col. 5 Paragraph 3). Then, as taught by Fucarile, because possession of the content should not necessarily grant authorization to use the content, the content license would be verified.

Appellant respectfully disagrees with this characterization of van Zoest and Fucarile.

As discussed above, the content that is discussed in Fucarile is content that is received from a server over a network (see, for example, col. 6, lines 23-25, col. 8, lines 62-67, and col. 9, lines 30-35). **This content of Fucarile is thus analogous to the electronic work of van Zoest.** van Zoest does not discuss that mere possession of the electronic work is enough to authorize access to the electronic work; rather, verification that the user possesses the physical work (e.g., the physical CD (see, van Zoest at col. 1, lines 61-64)) or some other verification is needed in van Zoest in order to access the electronic work. The license mechanism of Fucarile, then, is at best another mechanism by which the verification of van Zoest could be performed, and is not another verification performed in addition to the verification performed by van Zoest.

Accordingly, for at least these reasons, Appellant respectfully submits that claim 9 is allowable over van Zoest in view of Fucarile.

With respect to claim 10, given that claim 10 depends from claim 9, Appellant respectfully submits that claim 10 is likewise allowable over van Zoest in view of Fucarile for at least the reasons discussed above with respect to claim 9.

2. Claims 16, 17, and 20-28

As discussed above with respect to claim 9, Appellant respectfully submits that there is no suggestion or motivation to combine van Zoest and Fucarile, and thus that no *prima facie* case of obviousness has been established. One of ordinary skill in the art would not have been motivated to use the techniques of Fucarile to perform a verification that had already been performed by van Zoest. As there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to use the techniques of Fucarile to perform a verification that had already been performed by van Zoest, Appellant respectfully submits that it would not have been obvious to combine van Zoest and Fucarile.

Furthermore, with respect to claim 16, claim 16 recites:

A system comprising:
a memory to store one or more highly compressed content pieces;
a comparator, coupled to the memory, to compare the one or more highly compressed content pieces to content at the system and to determine whether the content matches at least one of the one or more highly compressed content pieces; and
a resolver, coupled to the comparator, to take a particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset, wherein the particular action comprises checking to see whether the system has a valid license for the content.

Appellant respectfully submits that no such system is disclosed or suggested by van Zoest in view of Fucarile.

In the September 20, 2005 Final Office Action at pp. 8-9, it was asserted that Fucarile discloses a resolver, coupled to the comparator, to take a particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset, wherein the particular action comprises checking to see whether the system has a valid license for the content as recited in claim 16.

However, as discussed above, in van Zoest once the user adequately shows that they are authorized to receive the requested work, the user is provided with access to the work (see, col. 2, lines 45-47). This verification can be performed by the user demonstrating that they own a physical copy of the work or demonstrating that they ordered the requested work from a retailer or other distributor (see, col. 2, lines 40-44). Possession of the physical work in van Zoest (not mere possession of the electronic work) or some other verification is needed in van Zoest. After the user in van Zoest has adequately shown that they are authorized to receive the requested electronic work by passing some verification that extends beyond merely having a copy of the electronic work, it would have been nonsensical for a check to then be made as to whether one of a plurality of licenses corresponds to the content. Such a check would simply verify what has already been verified by some other means.

In the September 20, 2005 Final Office Action at p. 3, it was asserted that “it would not have been nonsensical to check for a valid license once it was determined in van Zoest that the user possessed the content”. Appellant

respectfully disagrees and submits that it would have been nonsensical to check for a valid license once it was determined in van Zoest that the user was authorized to access the electronic work. The possession of the physical work in van Zoest authorizes the user to access the electronic work – there is no discussion or mention in either van Zoest or Fucarile of needing any additional authorization beyond such possession of the physical work. Authorization to access the electronic work in van Zoest is verified by the presence of the physical work. **Embedding a license of Fucarile in the electronic work in van Zoest would not be needed in combination with verifying the presence of the physical work in van Zoest because both would serve the same function – to verify authorization to access the electronic work.** As such, Appellant respectfully submits that it would have been nonsensical to check for a valid license in van Zoest to determine whether a user is authorized to access the electronic work after it was already determined that the user was authorized to access the electronic work.

In addition, in the December 12, 2005 Advisory Action it was asserted with respect to the combination of van Zoest and Fucarile that:

Regarding applicant's argument that the license system of Fucarile would not be performed in addition to the comparison of van Zoest and therefore would be nonsensical to make the combination, the examiner does not find the argument persuasive. Once again, the applicant has mischaracterized the rejection. In this case, the system would compare the content to a database of known content to determine whether the user was in possession of the physical work (See van Zoest Col. 5 Paragraph 3). Then, as taught by Fucarile, because possession of the content should not necessarily grant authorization to use the content, the content license would be verified.

Appellant respectfully disagrees with this characterization of van Zoest and Fucarile.

As discussed above, the content that is discussed in Fucarile is content that is received from a server over a network (see, for example, col. 6, lines 23-25, col. 8, lines 62-67, and col. 9, lines 30-35). **This content of Fucarile is thus analogous to the electronic work of van Zoest.** van Zoest does not discuss that mere possession of the electronic work is enough to authorize access to the electronic work; rather, verification that the user possesses the physical work (e.g., the physical CD (see, van Zoest at col. 1, lines 61-64)) or some other verification is needed in van Zoest in order to access the electronic work. The license mechanism of Fucarile, then, is at best another mechanism by which the verification of van Zoest could be performed, and is not another verification performed in addition to the verification performed by van Zoest.

Accordingly, for at least these reasons, Appellant respectfully submits that claim 16 is allowable over van Zoest in view of Fucarile.

With respect to claims 17 and 20-28, given that claims 17 and 20-28 depend from claim 16, Appellant respectfully submits that claim 17 and 20-28 are likewise allowable over van Zoest in view of Fucarile for at least the reasons discussed above with respect to claim 16.

3. Claim 37

As discussed above with respect to claim 9, Appellant respectfully submits that there is no suggestion or motivation to combine van Zoest and Fucarile, and thus that no *prima facie* case of obviousness has been established. One of

ordinary skill in the art would not have been motivated to use the techniques of Fucarile to perform a verification that had already been performed by van Zoest. As there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to use the techniques of Fucarile to perform a verification that had already been performed by van Zoest, Appellant respectfully submits that it would not have been obvious to combine van Zoest and Fucarile.

Furthermore, with respect to claim 37, claim 37 recites:

A method comprising:
comparing a portion of media content to a set of one or more highly compressed pieces of content;
determining whether the portion of media content matches any of the set of highly compressed pieces; and
taking a programmed action if the portion of media content matches any of the set of highly compressed pieces, wherein the programmed action comprises checking whether one of a plurality of licenses maintained at a content player performing the comparing corresponds to the portion of media content.

Appellant respectfully submits that no such method is disclosed or suggested by van Zoest in view of Fucarile.

In the September 20, 2005 Final Office Action at pp. 8 and 10, it was asserted that Fucarile discloses taking a programmed action if the portion of media content matches any of the set of highly compressed pieces, wherein the programmed action comprises checking whether one of a plurality of licenses maintained at a content player performing the comparing corresponds to the portion of media content as recited in claim 37.

However, as discussed above, in van Zoest once the user adequately shows that they are authorized to receive the requested work, the user is provided with

access to the work (see, col. 2, lines 45-47). This verification can be performed by the user demonstrating that they own a physical copy of the work or demonstrating that they ordered the requested work from a retailer or other distributor (see, col. 2, lines 40-44). Possession of the physical work in van Zoest (not mere possession of the electronic work) or some other verification is needed in van Zoest. After the user in van Zoest has adequately shown that they are authorized to receive the requested electronic work by passing some verification that extends beyond merely having a copy of the electronic work, it would have been nonsensical for a check to then be made as to whether one of a plurality of licenses corresponds to the content. Such a check would simply verify what has already been verified by some other means.

In the September 20, 2005 Final Office Action at p. 3, it was asserted that “it would not have been nonsensical to check for a valid license once it was determined in van Zoest that the user possessed the content”. Appellant respectfully disagrees and submits that it would have been nonsensical to check for a valid license once it was determined in van Zoest that the user was authorized to access the electronic work. The possession of the physical work in van Zoest authorizes the user to access the electronic work -- there is no discussion or mention in either van Zoest or Fucarile of needing any additional authorization beyond such possession of the physical work. Authorization to access the electronic work in van Zoest is verified by the presence of the physical work. **Embedding a license of Fucarile in the electronic work in van Zoest would not be needed in combination with verifying the presence of the physical work in van Zoest because both would serve the same function -- to verify**

authorization to access the electronic work. As such, Appellant respectfully submits that it would have been nonsensical to check for a valid license in van Zoest to determine whether a user is authorized to access the electronic work after it was already determined that the user was authorized to access the electronic work.

In addition, in the December 12, 2005 Advisory Action it was asserted with respect to the combination of van Zoest and Fucarile that:

Regarding applicant's argument that the license system of Fucarile would not be performed in addition to the comparison of van Zoest and therefore would be nonsensical to make the combination, the examiner does not find the argument persuasive. Once again, the applicant has mischaracterized the rejection. In this case, the system would compare the content to a database of known content to determine whether the user was in possession of the physical work (See van Zoest Col. 5 Paragraph 3). Then, as taught by Fucarile, because possession of the content should not necessarily grant authorization to use the content, the content license would be verified.

Appellant respectfully disagrees with this characterization of van Zoest and Fucarile.

As discussed above, the content that is discussed in Fucarile is content that is received from a server over a network (see, for example, col. 6, lines 23-25, col. 8, lines 62-67, and col. 9, lines 30-35). **This content of Fucarile is thus analogous to the electronic work of van Zoest.** van Zoest does not discuss that mere possession of the electronic work is enough to authorize access to the electronic work; rather, verification that the user possesses the physical work (e.g., the physical CD (see, van Zoest at col. 1, lines 61-64)) or some other verification is needed in van Zoest in order to access the electronic work. The license mechanism of Fucarile, then, is at best another mechanism by which the

verification of van Zoest could be performed, and is not another verification performed in addition to the verification performed by van Zoest.

Accordingly, for at least these reasons, Appellant respectfully submits that claim 37 is allowable over van Zoest in view of Fucarile.

Conclusion

The Office's basis and supporting rationale for the § 103(a) rejections is not supported by the teaching of the cited references. Appellant respectfully requests that the rejections be overturned and that pending claims 1-17 and 20-52 be allowed to issue.

Respectfully Submitted,

Dated: _____

4/20/06

By: _____

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(8) Appendix of Appealed Claims

1. A system comprising:
a source database storing a plurality of highly compressed content pieces;
and
a content player, coupled to the source database, including,
an interface to receive a subset of the plurality of highly compressed content pieces from the source database,
a storage device to store the subset,
a comparator to compare the subset to content and determine whether the content matches any of the plurality of highly compressed content pieces in the subset,
a resolver to take particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset, and
an output controller to render the content if the comparator indicates the content does not match any of the highly compressed content pieces in the subset.
2. A system as recited in claim 1, wherein the comparator is to compare the subset to content being played by the content player.
3. A system as recited in claim 1, wherein the content player is coupled to the source database via the Internet.

4. A system as recited in claim 1, wherein the plurality of highly compressed content pieces comprises a plurality of highly compressed audio pieces.

5. A system as recited in claim 1, wherein the plurality of highly compressed content pieces comprises a plurality of highly compressed video pieces.

6. A system as recited in claim 1, wherein the plurality of highly compressed content pieces comprises a plurality of highly compressed audio/video pieces.

7. A system as recited in claim 1, wherein the interface is further to subsequently communicate with the source database, retrieve a new subset of the plurality of highly compressed content pieces from the source database, and replace the subset in the storage device with the new subset.

8. A system as recited in claim 1, further comprising a content source coupled to the content player, and wherein the content player further comprises a compressor to receive content from the content source, generate a highly compressed content piece based on the received content, and add the generated highly compressed content piece to the subset in the storage device.

9. A system comprising:
a source database storing a plurality of highly compressed content pieces;
and
a content player, coupled to the source database, including,
an interface to receive a subset of the plurality of highly compressed
content pieces from the source database,
a storage device to store the subset,
a comparator to compare the subset to content and determine
whether the content matches any of the plurality of highly compressed
content pieces in the subset, and
a resolver to take particular action in response to the comparator
indicating the content matches one of the plurality of highly compressed
content pieces in the subset,
wherein the storage device is further to store a plurality of licenses
identifying content that a user of the content player is authorized to
playback, and wherein the particular action comprises the resolver checking
whether one of the plurality of licenses corresponds to the content.

10. A system as recited in claim 9, wherein each of the plurality of
highly compressed content pieces in the subset further indicates whether one of the
plurality of licenses is required for playback of the content.

11. A system as recited in claim 1, wherein the storage device is further
to store the content.

12. A system as recited in claim 1, further comprising a content source, coupled to the content player, from which the content is received.

13. A system as recited in claim 12, wherein the content player receives the content from the content source in its entirety before playback of the content begins.

14. A system as recited in claim 1, wherein the comparator is to determine whether the content matches any of the plurality of highly compressed content pieces in the subset by comparing a first set of feature values associated with each of the plurality of highly compressed content pieces with a second set of feature values associated with the content, and checking whether at least a threshold number of the first set of feature values is within threshold distance of the second set of feature values.

15. A system as recited in claim 14, wherein the first set of feature values and the second set of feature values each comprises a set of audio energy features.

16. A system comprising:
a memory to store one or more highly compressed content pieces;
a comparator, coupled to the memory, to compare the one or more highly compressed content pieces to content at the system and to determine whether the

content matches at least one of the one or more highly compressed content pieces;
and

a resolver, coupled to the comparator, to take a particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset, wherein the particular action comprises checking to see whether the system has a valid license for the content.

17. A system as recited in claim 16, wherein the content at the system comprises content being played by the system.

20. A system as recited in claim 16, wherein the memory is further to store the content.

21. A system as recited in claim 16, further comprising a playback controller, coupled to the memory, to receive the content from an external source.

22. A system as recited in claim 21, wherein the external source comprises a CD.

23. A system as recited in claim 16, further comprising an interface, coupled to the memory, to receive the one or more highly compressed content pieces from a compressed content source.

24. A system as recited in claim 16, further comprising a compressor, coupled to the memory, to receive content and generate the one or more highly compressed content pieces.

25. A system as recited in claim 16, wherein the comparator is to determine whether the content matches any of the plurality of highly compressed content pieces in the subset by comparing a first set of feature values associated with each of the plurality of highly compressed content pieces with a second set of feature values associated with the content, and checking whether at least a threshold number of the first set of feature values is within threshold distance of the second set of feature values.

26. A system as recited in claim 25, wherein the first set of feature values and the second set of feature values each comprises a set of audio energy features.

27. A system as recited in claim 16, wherein the system comprises a portable music player.

28. A system as recited in claim 16, wherein each of the one or more highly compressed content pieces further indicates whether a license is required for playback of the corresponding content.

29. A method comprising:

comparing a portion of media content to a set of one or more highly compressed pieces of content;

determining whether the portion of media content matches any of the set of highly compressed pieces;

taking a programmed action if the portion of media content matches any of the set of highly compressed pieces; and

playing back the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces.

30. A method as recited in claim 29, wherein the portion of media content comprises a song.

31. A method as recited in claim 29, wherein the portion of media content comprises a video clip.

32. A method as recited in claim 29, further comprising performing the comparing while the portion of media content is being played.

33. A method as recited in claim 29, further comprising performing the comparing while the portion of media content is being downloaded from a content source.

34. A method as recited in claim 29, further comprising receiving the set of highly compressed pieces from a highly compressed content piece source.

35. A method as recited in claim 34, further comprising subsequently receiving a new set of highly compressed pieces from the highly compressed content piece source, and replacing the set with the new subset.

36. A method as recited in claim 29, further comprising:
receiving content from a content source;
generating a highly compressed piece based on the received content; and
adding the generated highly compressed piece to the set of highly compressed pieces.

37. A method comprising:
comparing a portion of media content to a set of one or more highly compressed pieces of content;
determining whether the portion of media content matches any of the set of highly compressed pieces; and
taking a programmed action if the portion of media content matches any of the set of highly compressed pieces, wherein the programmed action comprises checking whether one of a plurality of licenses maintained at a content player performing the comparing corresponds to the portion of media content.

38. A method as recited in claim 29, wherein the determining comprises:
comparing a first set of feature values associated with each of the plurality of highly compressed pieces with a second set of feature values associated with the portion of media content; and

checking whether at least a threshold number of the first set of feature values is within threshold distance of the second set of feature values.

39. A method as recited in claim 38, wherein the first set of feature values and the second set of feature values each comprises a set of audio energy features.

40. One or more computer-readable memories containing a computer program that is executable by a processor to perform a method comprising:

comparing a portion of media content to a set of one or more highly compressed pieces of content;

determining whether the portion of media content matches any of the set of highly compressed pieces;

taking a programmed action if the portion of media content matches any of the set of highly compressed pieces; and

rendering the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces.

41. A system comprising:

means for storing a set of highly compressed content pieces;

means for determining whether a portion of media content matches any of the set of highly compressed content pieces;

means for taking a particular action if the portion of media content matches any of the set of highly compressed content pieces; and

means for playing back the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces.

42. A system as recited in claim 41, further comprising means for receiving an update set of highly compressed content pieces and replacing the set of highly compressed content pieces with the update set of highly compressed content pieces.

43. A system as recited in claim 41, further comprising means for receiving the set of highly compressed content pieces.

44. A system as recited in claim 41, further comprising means for generating the set of highly compressed content pieces.

45. A system as recited in claim 41, wherein the means for storing is further for storing the portion of media content.

46. One or more computer-readable media having stored thereon a plurality of instructions that, when executed by one or more processors of a computer, causes the one or more processors to perform acts including:

checking whether a portion of media content matches a piece of highly compressed content, wherein the piece of highly compressed content cannot be played back to a user in an intelligible form;

allowing the portion of media content to be played back if the portion of media content does not match the piece of highly compressed content; and

taking a particular action if the portion of media content does match the piece of highly compressed content.

47. One or more computer-readable media as recited in claim 46, wherein the portion of media content includes one or more of audio content and video content.

48. One or more computer-readable media as recited in claim 46, wherein the plurality of instructions further cause the one or more processors to perform acts including receiving the piece of highly compressed content from a highly compressed content source.

49. One or more computer-readable media as recited in claim 48, wherein the plurality of instructions further cause the one or more processors to perform acts including subsequently receiving a new piece of highly compressed content from the highly compressed content source, and replacing the piece with the new piece.

50. One or more computer-readable media as recited in claim 46, wherein the plurality of instructions further cause the one or more processors to perform acts including:

receiving content from a content source; and

generating the piece of highly compressed content based on the received content.

51. One or more computer-readable media as recited in claim 46, wherein the checking comprises:

comparing a first set of feature values associated with the piece of highly compressed content with a second set of feature values associated with the portion of media content; and

checking whether at least a threshold number of the first set of feature values is within threshold distance of the second set of feature values.

52. One or more computer-readable media as recited in claim 51, wherein the first set of feature values and the second set of feature values each comprises a set of audio energy features.

(9) Appendix of Evidence Submitted

None.

(10) Appendix of Related Proceedings

None.